



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/730,155	12/05/2000	Serse Giberti-Fornaciari	204,910	6866

7590

02/05/2003

Abelman, Frayne & Schwab  
150 East 42nd Street  
New York, NY 10017-5612

EXAMINER

VINCENT, SEAN E

ART UNIT

PAPER NUMBER

1731

DATE MAILED: 02/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/730,155

Applicant(s)

GIBERTI-FORNACIARI ET AL.

Examiner

Sean E Vincent

Art Unit

1731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 May 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Drawings***

1. Figures 1 and 2 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 4 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification as filed does not mention a second conduit integrated to a wall of the cylinder as a passage. Literal support for this limitation should be added to the specification to satisfy the description requirement.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. Claim 1 recites the limitation "the network of fluid admission and discharging passages" in lines 15-16. There is insufficient antecedent basis for this limitation in the claim.

"Admission" should be changed to "feeding."

7. Claims 3-5 recite limitations referring back to claims other than claim 1 resulting in a lack of antecedent basis for these limitations in the claims. It would appear that claim 3 should depend from claim 2, claim 4 should depend from claim 3 and claim 5 should depend from claim 3. Examples of the limitations lacking antecedent basis include: "the reel valve" in claim 3, lines 14 and 16; "the second conduit" and "the second fluid passage" in claim 4, lines 1 and 3 respectively; and "the first passage of the network of fluid feeding and discharging passages passing through the cylinder" in claim 5, lines 26-28.

8. Claim 1 is vague and confusing in line 6 for stating "and a five apertures" which is not grammatically correct or supported by the specification. It should be changed to "and a fifth apertures".

9. Claim 3 is vague and confusing in line 20 for stating "the valve means". It is not clear whether this refers to the aforementioned operating valve means or speed control valve means (or reel valve or needle valve).

10. Claim 5 recites the limitation "the valve chamber" in lines 31-32. There is insufficient antecedent basis for this limitation in the claim. It is possible that this reference was supposed to be to "the valve housing."

11. Claim 5 mentions "a fifth aperture" in line 24 and "a first aperture" in line 31. Since first and fifth apertures were introduced in claim 1 and line 5 of claim 5 mentions "the third aperture", it is not known if these first and fifth apertures are new or if they refer to the same apertures of

Art Unit: 1731

claim 1. Like line 5 of claim 5, these references should use “the” to clarify which apertures are meant.

***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

14. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dininio (US 4082108) in view of Pilskaer et al (US 5853449).

15. Dininio taught well known valve block assemblies for pneumatic cylinder and piston actuators (see figures and col. 1, line 60 to col. 2, line 54 and col. 3, line 8 to col. 6, line 27). Dininio did not teach fluid passages in the cylinder cap of each cylinder. Pilskaer et al taught plunger canisters and cooperating “conjunction boxes” using cooperating ports at the bottom of each plunger canister (see col. 13, line 42 to col. 17, line 37 and figures 31-38a). Pilskaer et al

Art Unit: 1731

discusses operating and speed control valve means connected to the conjunction box, but does not show them, suggesting that known valve means would have been expected to be compatible with the disclosed assemblies.

16. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate the modular design of Pilskaer et al into the fluid distribution arrangement of Dininio by connecting Dininio's valve block through Pilskaer et al's conjunction box because Pilskaer et al taught that it made the plunger canisters easily replaceable.

17. Dininio and Pilskaer et al both lack a teaching of fluid passages and valve means "practiced at the cylinder cap" per se. Claims 1-5 do not limit the relative placement of the cylinder and any associated tool to be actuated, therefore the "cylinder cap" could be interpreted to be on the opposite end of the cylinder from an actuated tool. While the fluid passage connection means of Pilskaer et al are located at the bottom of the plunger cylinders, the cylinders could obviously be inverted so that the connection means were at the top and the plunger would work from the bottom of the cylinder. Therefore, it would have been obvious to practice the valves of Dininio at the "cylinder cap" of Pilskaer et al.

Art Unit: 1731

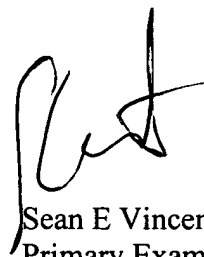
*Conclusion*

18. The prior art made of record and not relied upon is cited to further show the state of the art.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sean E Vincent whose telephone number is 703-305-3607. The examiner can normally be reached on M - F (8:30 - 6:00) Second Monday Off.

20. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P Griffin can be reached on 703-308-1164. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

21. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.



Sean E Vincent  
Primary Examiner  
Art Unit 1731

S Vincent  
January 27, 2003